

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number.	: 09/992,392	Confirmation Number.	: 7604
Applicants	: David K. Locke <i>et al.</i>		
Filed	: November 6, 2001		
TC/A.U.	: 3713		
Examiner	: Hoel, Matthew		
Docket Number	: 47079-00119USPT		
Customer Number	: 30,223		

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

AMENDMENT & RESPONSE TO THE FINAL OFFICE ACTION
MAILED MAY 18, 2006

Dear Commissioner:

This paper is being submitted in reply to the Final Office Action, mailed May 18, 2006, for which the three-month date for response is August 18, 2005. In response to the Final Office Action, the Applicants respectfully request the Examiner to consider the following remarks.

The Applicants' **Listing of Claims** begins on page 2 of this paper.

The Applicants' **Remarks** begin on page 7 of this paper.

Listing of Claims:

1. (Previously Presented) A slot machine comprising:
a rotatable reel, the reel bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element; and
a processor operable to
rotate the reel to give the continuous graphical element a first velocity and at least one of the plurality of discrete symbols a different second velocity; and
stop the reel and the plurality of discrete symbols to place the discrete symbols on the reel in visual association with a display area.
2. (Cancelled)
3. (Previously Presented) The slot machine of claim 1, further including means for determining a payout based, at least in part, on the discrete symbols associated with the display area.
4. (Original) The slot machine of claim 1, wherein the discrete symbols are superimposed over the graphical element.
5. (Original) The slot machine of claim 1, wherein the graphical element includes a trail.
6. (Original) The slot machine of claim 5, wherein the trail is selected from a group consisting of a road and a board game path.
7. (Original) The slot machine of claim 1, wherein the reel is simulated on a video display.
8. (Original) The slot machine of claim 1, wherein the reel is physical and driven by a stepper motor.

9. (Previously Presented) A slot machine comprising:

a rotatable reel, the reel bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element, the reel also bearing a discrete symbol; and

a processor to rotate the reel to give the continuous graphical element a first velocity and the discrete symbol a different second velocity to allow the discrete symbol to move between the adjacent ones of the discrete symbol positions as the reel is rotated.

10. (Previously Presented) The slot machine of claim 9, further including means for rotating and stopping the reel and the discrete symbol to place a portion of the reel in visual association with a display area.

11. (Original) The slot machine of claim 9, wherein the discrete symbol is superimposed over the graphical element.

12. (Original) The slot machine of claim 9, wherein the graphical element includes a trail.

13. (Original) The slot machine of claim 12, wherein the trail is selected from a group consisting of a road and a board game path.

14. (Original) The slot machine of claim 9, wherein the reel is simulated on a video display.

15. (Original) The slot machine of claim 9, wherein the reel is physical and driven by a stepper motor.

16. (Original) The slot machine of claim 9, further including means for determining a payout based on movement of the discrete symbol between the adjacent ones of the discrete symbol positions as the reel is rotated.

17. (Original) The slot machine of claim 16, wherein the payout accumulates based on each discrete symbol position traversed by the discrete symbol.
18. (Previously Presented) A method of conducting a slot game on a slot machine controlled by a processor, comprising:
 - receiving a wager from a player; and
 - rotating a reel, the reel bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element, the rotating reel moving the continuous graphical element at a first velocity;
 - moving at least one of the plurality of discrete symbols with a different second velocity relative to the graphical element; and
 - stopping the reel and the at least one discrete symbol to place a portion of the reel in visual association with a display area.
19. (Original) The method of claim 18, wherein the discrete symbols are superimposed over the graphical element.
20. (Original) The method of claim 18, wherein the graphical element includes a trail.
21. (Original) The method of claim 20, wherein the trail is selected from a group consisting of a road and a board game path.
22. (Original) The method of claim 18, wherein the reel is simulated on a video display.
23. (Original) The method of claim 18, wherein the reel is physical and driven by a stepper motor.
24. (Original) The method of claim 18, further including determining a payout based, at least in part, on the portion of the reel associated with the display area.

25. (Previously Presented) A method of conducting a slot game on a slot machine controlled by a processor, comprising:
- receiving a wager from a player;
 - rotating a reel with a first velocity, the reel bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element; and
 - moving a discrete symbol with a different second velocity between the adjacent ones of the discrete symbol positions as the reel is rotated.
26. (Original) The method of claim 25, further including stopping the reel to place a portion of the reel in visual association with a display area.
27. (Original) The method of claim 25, wherein the discrete symbol is superimposed over the graphical element.
28. (Original) The method of claim 25, wherein the graphical element includes a trail.
29. (Original) The method of claim 28, wherein the trail is selected from a group consisting of a road and a board game path.
30. (Original) The method of claim 25, wherein the reel is simulated on a video display.
31. (Original) The method of claim 25, wherein the reel is physical and driven by a stepper motor.
32. (Original) The method of claim 25, further including determining a payout based on movement of the discrete symbol between the adjacent ones of the discrete symbol positions as the reel is rotated.

33. (Original) The method of claim 32, wherein the payout accumulates based on each discrete symbol position traversed by the discrete symbol.
34. (Cancelled) The slot machine of claim 1, wherein the rotatable reel is only a single reel.
35. (Cancelled) The slot machine of claim 9, wherein the rotatable reel is only a single reel.
36. (Cancelled) The method of claim 18, wherein the reel is only a single reel.
37. (Cancelled) The method of claim 25, wherein the reel is only a single reel.

REMARKS

Claims 1 and 3-33 are pending in the patent application. Claims 34-37 are hereby cancelled without prejudice or disclaimer to expedite prosecution.

Applicant thanks the Examiner for the courtesy of the Examiner interview, which was conducted on August 9, 2006, between Matthew Hoel, Xuan Thai, and William Pegg. The standing 35 U.S.C. §§ 101, 112, and 103 rejections were discussed during the Examiner interview, consistent with at least some of the following remarks, but agreement was not reached.

1. THE 35 U.S.C. § 112, 1ST PARAGRAPH REJECTION

Claims 8, 15, 23, 31 and 34-37 are being rejected under 35 U.S.C. § 112, 1st paragraph as failing to comply with the enablement requirement. This rejection is traversed.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Enablement is a question of law involving underlying factual inquiries. *Id.* at 737 (holding that whether undue experimentation is required is a “conclusion reached by weighing many factual considerations. . . . includ[ing] (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”).

During the Examiner interview, the Examiner cited *In re Donohue*, 550 F.2d 1269, 1271, 193 USPQ 136, 137 (CCPA 1977), stating that a lack of enablement was caused by lack of information in the specification about a single block labeled “LOGIC” in the drawings.

However, the CCPA further pointed out that “Employment of block diagrams and descriptions of their functions is not fatal under 35 U.S.C. § 112, first paragraph, providing the represented structure is conventional *and can be determined without undue experimentation.*” Contrary to the Examiner’s position, *In re Donohue* does not relieve the Examiner of the burden to factually establish the underlying factual predicate upon which a conclusion of undue experimentation can be properly drawn. It is noted that it is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (“[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). In *In re Zurko*, the court explained that, “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” but also made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697. An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697.

Further, as to the Examiner’s reliance in the rejection upon the claimed recitation of “a reel” as disclosing only a single reel (*e.g.*, “[t]he examples found by the examiner in the prior art are not ‘a reel’ per se; they are . . . two concentric reels”; see page 3, lines 1-2 of the Office Action). This interpretation fails is improper and contrary to established case law. Generally, use of an indefinite article (*e.g.*, “a” or “an”) indicates “one or more.” *See, e.g., Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, 279 F.3d 1357, 1370, 61 USPQ2d 1647 (Fed. Cir. 2002) (“It is well settled that the term ‘a’ or ‘an’ ordinarily means ‘one or more’”);

Crystal Semiconductor Corp. v. TriTech Microelectronics International, Inc., 246 F.3d 1336, 1347, 1350-51, 57 USPQ2d 1953 (Fed. Cir. 2001).

A. A PRIMA FACIE CASE HAS NOT BEEN SET FORTH BY THE EXAMINER

The Examiner has failed to set forth a *prima facie* case under 35 U.S.C. § 112, first paragraph and this rejection must be withdrawn for at least the reason that the Examiner has failed to address the factors set forth in *In re Wands*.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. *See, e.g.*, MPEP § 2164.01. The Examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence *as a whole*. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407. Instead, the Examiner's soliloquy draws conclusions based on personal opinions insufficient to qualify as "official notice" and fails to examine the requisite factors. The Examiner has, accordingly, failed to set forth evidence supporting a conclusion that the level of experimentation required, in view of the above factors, would be "undue" and failed to set forth a *prima facie* case under 35 U.S.C. § 112, first paragraph.

B. THE EXAMINER'S ADMISSION ESTABLISHES ENABLEMENT

The Examiner acknowledges that present concepts are "clearly" enabled by the video-display based example disclosed in the specification (*see, e.g.*, Final Office Action, page 6, lines 9-12). The Examiner contends, however, that an embodiment of the concepts employing physical reels and stepper motors is not enabled and that such embodiment would require undue experimentation to arrive at what is claimed.

While alleging, on one hand, that a mechanical embodiment recited in claims 8, 15, 23, 31 and 34-37 has not been enabled, the Examiner acknowledges, on the other hand, that "[o]ne of

ordinary skill in the art could reasonably consider the inner and outer reels of Inoue ('881) to be a single reel, since they are concentric, rotating about the same point in the same plane, and are used in place of and for the same function as the single reel used in most slot machines.” *Id.* at page 7, line 16 to page 8, line 1. Thus, based on the Examiner’s admission, one of ordinary skill in the art at the time of the invention would have understood the disclosed physical reels and stepper motors to have included (but not be necessarily limited to) concentric or nested reels. This is evidence of one potential implementation, absent any undue experimentation, which applies the novel and non-obvious concepts disclosed by the inventors to conventional technology. The Examiner’s admission underscores the impropriety of this rejection, particularly as to claims 8, 15, 23, and 31, and contradicts the Examiner’s statement that “[t]here is simply no way to mechanically implement these claims with both the continuous graphical element and the discrete symbols being borne on the same individual reel.” *Id.* at page 8, lines 1-3.

As noted above, the standard to be applied in determining enablement is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *In re Wands, supra*. Such analysis is informed by the specification disclosure, which does not state that the only way to implement the physical reel embodiment is to dispose the disclosed continuous graphical element and discrete symbols “on the same individual reel,” as asserted by the Examiner. The specification does not limit the implementation of the disclosed concepts to a particular type of reel or a particular technology or practice. Enablement requires, however, simply that one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. This standard has been satisfied.

Accordingly, Applicant submits that the Examiner's 35 U.S.C. § 112, 1st paragraph rejection is factually and legally erroneous and must be withdrawn.

3. THE 35 U.S.C. § 101 REJECTION

The Examiner rejected claims 8, 15, 23, 31 and 34-37 under 35 U.S.C. § 101 "because the disclosed invention is inoperative and therefore lacks utility." Applicant traverses this rejection and asserts that each of these claims possesses utility (*see, e.g.*, page 1, lines 4-22).

The Examiner has the initial burden of challenging an asserted utility. Only after the Examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the Applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility. *In re Swartz*, 232 F.3d 862, 863, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000); *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (*citing In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)). The Examiner has not discharged the initial burden incumbent thereupon to challenge the asserted utility.

In most cases, an Applicant's assertion of utility creates a *presumption of utility* that will be sufficient to satisfy the utility requirement of 35 U.S.C. § 101. *See, e.g., In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Irons*, 340 F.2d 974, 144 USPQ 351 (CCPA 1965); *In re Langer*, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974); *In re Sichert*, 566 F.2d 1154, 1159, 196 USPQ 209, 212-13 (CCPA 1977). As the Court of Customs and Patent Appeals stated in *In re Langer*:

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for

the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope.

Langer and subsequent cases direct the Office to presume that a statement of utility made by an Applicant is true. *See In re Langer*, 503 F.2d at 1391, 183 USPQ at 297; *In re Malachowski*, 530 F.2d 1402, 1404, 189 USPQ 432, 435 (CCPA 1976); *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

To overcome this presumption, the Examiner must determine if the assertion of utility is credible (*i.e.*, whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided). An assertion is credible *unless* (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based are inconsistent with the logic underlying the assertion. In the present case, Applicant's assertion of utility is both logical and sound. The asserted utility would not be considered by a person of ordinary skill to be "incredible in view of contemporary knowledge," nor does such asserted utility run counter what contemporary knowledge might otherwise suggest.

Simply stated, the Examiner has not set forth a *prima facie* showing that the claimed invention lacks utility, nor has he provided a sufficient evidentiary basis for factual assumptions asserted to support such alleged *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975)(*stating* the Examiner "must do more than merely question operability" and "must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability.").

As the Federal Circuit has stated, "[t]o violate [35 U.S.C.] 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices*,

Inc., 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992) (emphasis added). See also *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980) (“A small degree of utility is sufficient . . . The claimed invention must only be capable of performing some beneficial function . . . An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely . . . A commercially successful product is not required . . . Nor is it essential that the invention accomplish all its intended functions . . . or operate under all conditions . . . partial success being sufficient to demonstrate patentable utility . . . In short, the defense of non-utility cannot be sustained without proof of total incapacity.”

The Examiner’s assertion of inoperativeness appears to be premised upon the Examiner’s construction that, “if both the symbols and the continuous graphical element are borne on the same individual mechanical reel, they cannot move at two different velocities at the same time.” As to at least claims 8, 15, 23, and 31, which are not expressly limited to an “individual mechanical reel,” such allegation is manifestly in error for at least the reason that the claims do not recite an “individual mechanical reel” and that an interpretation strictly limiting these claims to such interpretation is improper in view of, for example, *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, *supra*, and *Crystal Semiconductor Corp. v. TriTech Microelectronics International, Inc.*, *supra*.

Reconsideration and withdrawal of this rejection is requested for at least the above reasons.

4. THE 35 U.S.C. § 103 REJECTION OVER DAVIES AND WALKER

Claims 1-4, 7-11, 14-19, 22-27 and 30-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Davies** (GB 2 330 936) in view of Walker et al. (U.S. 6,095,921) (hereinafter "**Walker**"). This rejection is respectfully traversed.

The Examiner alleges **Davies** discloses all of the elements of claim 1, but acknowledges that **Davies** does not teach a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element. **Walker** is relied upon for a teaching of a continuous graphical element (*citing* FIGS. 4B-C). The Examiner asserts that the combination of the device of **Davies** with the alleged continuous graphical element **Walker** would have been obvious at the time of the invention to one of ordinary skill in the art. This combination would yield, according to the Examiner, "a slot machine with the continuous graphical element on the inner band and a plurality of discrete symbols on the outer band" which would "allow the reel to rotate the continuous graphical element at a first velocity and the symbols at a second velocity." The Examiner further asserts that the continuous graphical element would cover the entire width of the inner band (*citing* **Walker**, FIGS. 4B-C) extending between and visually unifying the symbols (*citing* **Walker**, FIG. 4A). This combination would purportedly "stimulate players' interest in the game by providing a visual contrast by having an inner band with a continuous background (graphical element), and a transparent outer band with symbols superimposed over the background." The continuous background is asserted to "provide an appealing contrast without interfering with the player's ability to clearly see the symbols."

A. ALL ELEMENTS NOT TAUGHT OR SUGGESTED

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)(*stating* “[w]hen evaluating the scope of a claim, every limitation in the claim must be considered”).

Applicant submits that the proffered combination of **Davies** and **Walker** fails to teach or suggest a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element (claims 1, 18) or a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element (claims 9, 25).

Davies teaches a reel comprising an outer reel (*e.g.*, 2) and an inner reel (*e.g.*, 1), as shown in FIG. 1. The assembly has “two symbol-bearing endless bands one within the other and movable around their own loops, the outer one having a transparency that makes the portion presented to the player, *when movement ceases*, display an overlay of one symbol over another” (col. 2, lines 4-8)(emphasis added). **Davies** further teaches, for example, that “the outer, transparent reel band will have opaque numbers, letters or symbols on it that will generally not completely mask the symbols on the inner reel band” so that “[t]he player may see on the win line, for example, a bunch of cherries overlaid by the numeral 7” (page 3, lines 3-7).

The cited portion of **Walker** teaches that the conventional symbols have been *replaced* with an indicium 418 representing a visual continuum of values, in this case, width, such that an infinite number of positions may be represented by the reel (col. 6, lines 11-25). As shown in

FIG. 6, the value displayed in reel width display 208 indicates the width of reel strip 132 at the point at which it intersects payline 235. The value displayed in total width display 214 is the total width of all three reel strips and indicates the outcome of the slot play (*e.g.*, a total width of 2.950 inches corresponds to a payout of ten coins for each coin wagered) (col. 8, lines 10-18).

Davies' teaching of a reel comprising an outer reel (*e.g.*, 2) and an inner reel (*e.g.*, 1), as shown in FIG. 1, even in combination with the asserted indicium 418 of **Walker** is still legally and factually insufficient to render obvious the independent claims 1, 9, 18 and 25, or claims depending therefrom. The indicium 418 of **Walker** (*i.e.*, the graphics on the inner reels) does not extend between adjacent discrete symbols and, instead, replaces symbols entirely. Moreover, even in the context of the claimed combination, the indicium 418 of **Walker** would not "unify" the discrete symbols or discrete symbol positions borne by the reel. In other words, the indicium 418 of **Walker** is not a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element (*e.g.*, claim 1, see also claim 18), or a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element (*e.g.*, claim 9, see also claim 25).

Not only must every limitation of the claim be evaluated in ascertaining the proper scope of the claim, but claims must also be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ (Fed. Cir. 1983). The claimed continuous graphical element must unify the discrete symbols or discrete symbol positions, not merely provide visual contrast therefore (*i.e.*, "The advantage of this combination would be to stimulate players' interest in the game by providing a visual contrast" (page 11, numbered paragraph 25 of Office Action)). Examples of the claimed continuous graphical element are disclosed, for

example, in FIGS. 3-8 of Applicant's application. FIGS. 3-6 shows "a plurality of discrete symbols 60 and a continuous graphical element 62 extending between adjacent ones of the discrete symbols 60 such that the discrete symbols 60 are unified by the graphical element 62" (see par. [0014] of application). FIG. 7 shows another example of a continuous graphical element 70 formed by a plurality of spaces generally representative of a Monopoly™ board. FIG. 8 shows that, during the token race, each token 72 moves along the continuous graphical element 70 (*e.g.*, Monopoly board path), between adjacent ones of the discrete Monopoly board spaces, as the associated reel is rotated. The "broadest reasonable interpretation" of the claims permitted by law must be consistent with "the interpretation that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, "[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'.*" *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983)(italics added).

In view of the above, it is respectfully submitted that the Examiner has not set forth a *prima facie* case of obviousness for want of the requisite factual basis. The factual showing must be clear and particular. See, *e.g.*, *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *CR. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). It is submitted that the Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged for at least this reason. Reconsideration and withdrawal of this obviousness rejection of claims 1-4, 7-11, 14-19, 22-27 and 30-37 over **Davies** and **Walker** is requested at least upon this ground.

B. PROFFERED MOTIVATION TO MODIFY DAVIES IS LEGALLY INSUFFICIENT

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. *See, e.g., Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Instead, “[t]he prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” That which is or may be within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980).

Indeed, it is well settled that there must be some motivation that would have led one of ordinary skill in the art to combine references or modify references to arrive at the claimed invention. *See, e.g., B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *Al-site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). Thus, although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); *In re Fritch*, 972 F.2d at 1260 (Fed. Cir. 1992)).

The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the showing must be clear and particular. *See, e.g., In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). Broad conclusory statements, standing

alone, are not “evidence” supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

“The factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). It must be based on objective evidence of record. *In re Sang-Su Lee*, 277 F.3d 1338, 1345-46 (Fed. Cir. 2001); *see also In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002). “A showing of a suggestion, teaching, or motivation to combine the prior art reference is an ‘essential component of an obviousness holding’” *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000); *quoting C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). The need for specificity pervades this authority. *In re Sang-Su Lee, supra*, *citing In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000)(“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”).

The factual question of motivation is material to patentability cannot be dispensed with by a generalized assertion. In *In re Sang-Su Lee, supra*, the court admonished the Board of Patent Appeals and Interferences for failing to perform a “thorough and searching” factual inquiry in its reliance on the Examiner’s “conclusory statements,” emphasized that “determination of patentability must be based on evidence,” and stated that the board “cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims.”

In view of this overwhelming precedent setting forth the evidentiary requirements for setting forth a *prima facie* case of obviousness under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner’s stated motivation for combination of the references (*i.e.*, “[t]he

continuous background would provide an appealing contrast without interfering with the players' ability to clearly see the symbols") is conclusory and fails to satisfy the evidentiary requirements required to establish a *prima facie* case of obviousness. There appears to be absolutely no teaching or suggestion in either **Davies** or in **Walker** to "improve contrast" or make a more "appealing" contrast. Neither **Davies** nor **Walker** raises contrast as an issue. Moreover, the Examiner has failed to show that **Davies** or **Walker** teach or suggest reasons why a skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the element from **Walker** for combination with the elements of **Davies** in the manner claimed. There is simply no cognizable suggestion or motivation in either reference to make the proffered combination.

The legal concept of *prima facie* obviousness is a procedural tool of patent examination, allocating the burdens of going forward with production of evidence in each step of the examination process (*citations omitted*)(see, e.g., MPEP § 2142). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker* 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Withdrawal of this rejection and allowance of claims 1-4, 7-11, 14-19, 22-27 and 30-37 is therefore requested for at least this reason.

C. THE REFERENCES FAIL TO SUGGEST "INVENTION AS A WHOLE"

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*,

713 F.2d 1530 (Fed. Cir. 1983). Distilling the invention down to the “gist” of an invention disregards the requirement of analyzing the subject matter “as a whole.”

“[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” *In re Spinnoble*, 405 F.2d 578, 585 (CCPA 1969).

In the case at hand, the rejected claims relate to a wagering game machine which, for example (see numbered paragraph [0014]), has reels with a plurality of discrete symbols 60 and a continuous graphical element 62 extending between adjacent ones of the discrete symbols 60 such that the discrete symbols 60 are unified by the graphical element 62. The only teaching of this combination of elements is found within the Applicant’s disclosure. Both **Davies** and **Walker** appear devoid of any mention of such unification of discrete symbols by a graphical element. Any reliance on the Applicant’s disclosure to support the rejection is improper. “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (*see also In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The rejection therefore fails, on its face, to provide a showing that the invention is taught or suggested by **Davies** or **Walker** and the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). It is submitted that the Examiner’s burden to set forth a *prima facie* case of obviousness has not been discharged for at least this reason. Reconsideration and withdrawal of this obviousness rejection of claims 1-4, 7-11, 14-19, 22-27 and 30-37 over **Davies** and **Walker** is requested at least upon this ground.

5. **THE 35 U.S.C. § 103 REJECTION OVER DAVIES AND WALKER**

Claims 5-6, 12-13, 20-21 and 28-29 are being rejected under 35 U.S.C. § 103(a) as being unpatentable over **Davies** in view of **Walker** and Demar et al. (U.S. 6,203,429) (hereinafter "**Demar**"). This rejection is respectfully traversed.

Claims 5-6, 12-13, 20-21 and 28-29 are asserted to be patentable over the combination of **Davies**, **Walker** and **Demar** for at least the reasons set forth above and such remarks are applied herein, but are not replicated for brevity. In view of the above, since **Davies** and **Walker** fail to teach or suggest each and every element of the invention of the base claims from which claims 5-6, 12-13, 20-21 and 28-29 depend and fail to teach or suggest the modification and/or combination proffered by the Examiner to arrive at these base claims, and since **Demar** has not been shown to cure the deficiencies of **Davies** and **Walker** in this regard, reconsideration and withdrawal of this obviousness rejection is requested at least upon the grounds presented above in numbered paragraph 4.

Demar is alleged to teach a "graphical element that is a train in the form of a game board path (300, Fig. 8; col. 12, Lines 29 to 34)" (*see* page 15, numbered paragraph 38 of Office Action). The Examiner concludes that "[i]t would be obvious to one of ordinary skill in the art to apply the trail of '429 to the combination of '936 and '921. . . to enhance interest in the game by providing a consistent, predictable theme (in this case, a popular board game) for the continuous background" *Id.* However, there appears to be no teaching or suggestion, in any of **Davies**, **Walker** or **Demar**, of incorporating the board game 300 depicted in **Demar** (*i.e.*, the asserted continuous graphical element) into a reel, let alone for the purpose of, for example, unifying a plurality of discrete symbols associated therewith.

The Examiner's suggestion that "[t]he trail of '429 can be thought of as a loop, since it can be cycled through multiple times" and conclusion therefrom that "[i]t would thus be natural to apply the trail of '429 to one of the bands of '936 as the bands of '936 repeat multiple times" finds no basis or support in any of **Davies, Walker** or **Demar**. What is characterized by the Examiner as "natural" is anything but natural and has not been shown to be taught or suggested by any of the applied references.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, *guided only by the prior art references and the then-accepted wisdom in the field*. See *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Applicant submits that the ease with which the Examiner arrives at the combination of elements, without any supporting suggestion for such modifications and combinations from the very references cited, is evidence that the Examiner failed to closely adhere to this methodology. The only teaching of this combination is found within the Applicant's disclosure. Any reliance on the Applicant's disclosure to support the rejection is improper. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (*see also In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) *stating* "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure.")). See also *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Applicant submits that the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. § 103 for at least this reason. Withdrawal of this 35 U.S.C. § 103 rejection is requested for at least this reason.

6. CONCLUSION


It is the Applicant's belief that all of the claims are patentable and are in condition for allowance, and action towards that end is respectfully requested.

If the Examiner maintains the rejection, Applicant respectfully requests identification of the reference(s) relied upon to support the Examiners contentions of teachings and suggestions that are asserted to be well-known (*see, e.g.*, MPEP § 2144.03; 37 C.F.R. § 1.104(c)(2); *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697). Applicant respectfully traverses these contentions.

No fees are believed necessary. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00119USPT.

Respectfully submitted,

Date: August 16, 2006


William D. Pegg
Reg. No. 42,988
JENKENS & GILCHRIST, P.C.
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-3900 – Telephone
(312) 425-3909 – Facsimile

Attorneys for Applicants